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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/524,143   | 02/11/2005  | Volker Henninge      | 264612US0XPCT       | 2418             |
| 22850  | 7590        | 04/14/2008           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | RHEE, JANE J        |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1795                |                  |
|  |             |                      | NOTIFICATION DATE   | DELIVERY MODE    |
|  |             |                      | 04/14/2008          | ELECTRONIC       |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## **DETAILED ACTION**

### ***Rejection Repeated***

1. The 35 U.S.C. Double patenting rejection of claims 1-12, 24-25 over copending application 10504144 in view of Omea et al. has been repeated as previously made in office action 11/16/07.
2. The 35 U.S.C. 103(a) rejection of claims 1-6,9-12,24-25 unpatentable over Yen in view of Omae et al. has been repeated as previously made in office action 11/16/07.
3. The 35 U.S.C. 103(a) rejection of claims 7-8 unpatentable over Yen in view of Omae et al. and in further view of Kung has been repeated as previously made in office action 11/16/07.

### ***Response to Arguments***

4. Applicant's arguments filed 2/5/08 have been fully considered but they are not persuasive.

In response to applicant's argument that Yen does not disclose a porous inorganic coating, Yen teaches inorganic fillers that are added as part of the encapsulation sheath to improve the wettability of the nonwoven thus the inorganic fillers are considered the inorganic coating because the inorganic fillers is on and in the nonwoven material as desired by applicant's claim 1.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yen teaches a wettable non woven battery separator and Omae et al. teaches a nonwoven battery separator that is excellent in liquid retaining and absorbing characteristics with pore radius of 25-100um. Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide, Yen with a separator comprising a pore radius of 25-100um in order to be excellent in solution retention and absorbency as taught by Omae et al. Both Yen and Omae et al. teaches same nonwoven separator material for the secondary batteries, therefore, it would have been obvious to provide the same separator material with optimal pore radius taught by Omae et al. in order to provide Yen with a separator comprising optimal results.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yen teaches a wettable non woven battery separator and Kung teaches a wettable nonwoven separator. Yen teaches organic fillers in the nonwoven separator and Kung teaches organic fillers in the nonwoven separator. Yen fail to teach the particle size of the

organic fillers and Kung teaches oxide particies having the desired average particle size for the purpose of providing a separator that is excellent in tensile strength , wicking properties, wettability and alkali resistance (col. 2 lines 3-4). Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide, Yen with oxide particies having the desired average particle size from 0.5 to 7 .mu.m in order to provide a separator that is excellent in tensile strength , wicking properties, wettability and alkali resistance (col. 2 lines 3-4) as taught by Kung.

In response to the arguments concerning the double patenting rejection wherein Omae et al. does not that the pore size disclosed have any applicability in the battery separator claimed, both Yen and Omae et al. teaches same nonwoven separator material for the secondary batteries, therefore, it would have been obvious to provide the same separator material with optimal pore radius taught by Omae et al. in order to provide Yen with a separator comprising optimal results such as being excellent in liquid retaining and absorbing characteristics.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE RHEE whose telephone number is (571)272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jane Rhee/  
Primary Examiner, Art Unit 1795  
4/3/08

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